

DISCUSSION OF THE AMENDMENT

Claims 1 and 3 have been amended by deleting alkoxyated fatty alcohols from the hydrophobic compound Markush group. Claim 1 has been further amended by inserting that the dispersion excludes alkoxyated fatty alcohols, as supported by the specification at page 3, line 27 that alkoxyated fatty alcohols may optionally be, but are not required to be, present; and that the dispersion excludes fatty acids of 12 to 26 carbon atoms, as supported by the specification at page 3, line 31 that such fatty acids may optionally be, but are not required to be, present. See *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977) (holding that a claim to a genus with a recital of a negative proviso that did not appear in the specification complied with the description requirement.)

New Claims 20-22 have been added. Claim 20 is analogous to above-amended Claim 1, but limits the hydrophobic compound Markush group therein to the group consisting of alcohols of at least 12 carbon atoms and 3-thiaalkan-1-ols, but does not exclude alkoxyated fatty alcohols from the claim. Claims 21 and 22 are supported by Claim 20.

No new matter is believed to have been added by the above amendment. Claims 1, 3-9, 12-16 and 18-22 are now pending in the application. Of these claims, Claims 12-15 stand withdrawn from consideration.

REMARKS

As a preface to the prior art rejections discussed below, it is noted that the Examiner has not commented on Applicants' discovery herein and the comparative data in the specification, previously discussed. While Applicants contend that the above-discussed amendment is sufficient to overcome the rejections, the comparative data is further evidence of patentability and should also be considered if prior art rejections adopting different prior art and/or rationales are made in the future.

Thus, Applicants have discovered that when components (i) and (ii) of the present claims are used together, defoaming is obtained that is better than the use of either component (i) or (ii) alone, based on the same total amount of antifoam. Described in the specification beginning at page 14, Examples 1-3 are according to the presently-claimed invention. Comparative Examples 1-4 are for purposes of comparison, each of which contains only one of the two components (i) and (ii). As described in the specification at page 19, lines 36-40, the examples and comparative examples were tested for their antifoam or deaerating effect when used in amounts of 5 or 3 ppm, based on dry paper stock. The results are shown in the table at page 20 of the specification, reproduced below:

Example	Comparative example	Air content in % by volume with use of			
		5 ppm, based on dry matter, of deaerator		3 ppm, based on dry matter, of deaerator	
		lowest value	average over 5 min	lowest value	average over 5 min
1	-	0.40	0.68	0.83	1.02
-	1	0.85	1.1	1.01	1.22
2	-	0.38	0.75	0.98	1.20
-	2	0.82	1.03	1.03	1.18
3	-	0.42	0.72	0.80	1.05
-	3	0.88	1.12	0.98	1.21
-	4	1.01	1.23	1.10	1.22

As Applicants describe in the specification at page 20, lines 17-19, “the combination of polyglyceryl esters with ethylenebisstearamide has an improved effect compared with the use of the individual components.”

The rejections of Claims 1, 3-4, 7-9 and 18-19 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over, DE 19857204, as evidenced by US 6,340,662 (Millhoff et al); and of Claim 5 under 35 U.S.C. § 103(a) as unpatentable over Millhoff et al, are respectfully traversed.

The Examiner now relies on Millhoff et al’s disclosure of at least the 3x-ethoxylated C12-14 fatty alcohol in Table 1 thereof as meeting the present hydrophobic compound limitation. In reply, alkoxylated alcohols have now been deleted from the claims. Accordingly, it is respectfully requested that these rejections be withdrawn.

The rejection of Claim 16 under 35 U.S.C. § 103(a) as unpatentable over Millhoff et al in view of US 5,700,351 (Schuhmacher et al) or US 5,236,499 (Wegner et al), is respectfully traversed. The disclosures and deficiencies of Millhoff et al have been discussed above. Neither Schuhmacher et al nor Wegner et al remedy these deficiencies. Schuhmacher et al and Wegner et al have been relied on for a disclosure of polyglyceryl ester mixtures. However, even if such mixtures were used in Millhoff et al, the result would still not be the presently-claimed invention. Accordingly, it is respectfully requested that these rejections be withdrawn.

The rejection of Claims 1, 3-9, 16 and 18-19 under 35 U.S.C. § 103(a) as unpatentable over US 4,626,377 (Kavchok et al) taken with Schuhmacher et al or Wegner et al, is respectfully traversed.

The Examiner finds that the use of the term “comprising” in the claims does not exclude the fatty acids required by Kavchok et al, even though fatty acids have been deleted from the hydrophobic compound Markush group in the claims. In reply, such fatty acids

Application No. 10/519,405
Reply to Office Action of May 5, 2008

have now been deleted from the claims *per se*. Schuhmacher et al and Wegner et al have been discussed above. Thus, even if polyglyceryl esters disclosed therein were incorporated into the composition of Kavchok et al, the result would still not be the presently-claimed invention. Accordingly, it is respectfully requested that this rejection be withdrawn.

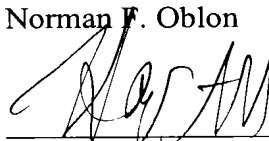
The rejection of Claim 3 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Claim 3 does limit the subject matter of Claim 1 in that the fatty acid ester member of the hydrophobic compound Markush group limits the monohydric to tetrahydric alcohol component to 3 to 22 carbon atoms, while it is 1 to 24 carbon atoms in Claim 1. Accordingly, it is respectfully requested that this rejection be withdrawn.

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon



Harris A. Pitlick
Registration No. 38,779

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)

NFO:HAP\la